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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/658,141 | 09/08/2000 | Yoshimasa Utsumi | 450100-02701 | 3562 |

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EXAMINER

VENT, JAMIE J

ART UNIT PAPER NUMBER

2613

DATE MAILED: 05/20/2004

[Handwritten signature]

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,141

Applicant(s)

UTSUMI, YOSHIMASA

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 0200.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (US 6,020,982) in view of Watanabe et al (US 5,590,306).

[claims 1, 10, 13, & 22]

In regard to claims 1, 10, 13, and 22, Yamauchi et al discloses a terminal apparatus and a recording apparatus with corresponding method comprising:

- Insertion hole into which a first and second memory card for recording with the memory cards being substantially the same shape (Figure 60 shows the one insertion hole for a memory card as claimed while Figure 62 shows insertion holes for two memory cards like that shown in applicant's Figure 1. Thereby both limitations are anticipated by the reference. Furthermore, Figure 61 shows two memory cards both being the same shape);
- Judging means for judging whether a memory card inserted into said insertion hole is either first or second memory card (Figure 39a step s3 shows the process of determining which memory card has been entered into the insertion hole);
- Recording means which, if said judging means judges that said first or second memory card is inserted preparatory to recording contents then records the

contents to the first or second memory card (Figure 105a shows the judgment of the type of source, first or second memory card, and thereby determines what destination, first or second memory card, should the contents be recorded. It is anticipated that this method can be done in two ways depending on the number of insertion holes. If one slot is present the data would be read from the memory card in the insertion hole and the data would be sent to hard drive. Depending on the results from the judgment factor user would enter another memory card, first or second, for recording. If two slots were present the data will simply be judged and transferred from the respected memory cards as depicted in the display V25 of Figure 105a);

- Controlling means if the first or second memory card is inserted into the insertion hole after the recording means has recorded the contents to the first or second memory card and then transfers the recorded contents from the first or second memory card to the inserted first or second memory card (Figure 105a shows the controlling of the storing and image copies of the two memory cards as well as recording source and contents as further explained in Column 55 Lines 50-65);

Yamouchi: however, lacks the recording contents to be copyright-protected and copyright unprotected.

Watanabe et al discloses a system with copyright-protected (read) and copyright-unprotected (write) as seen in Figure 5. The write protected or read protected bits of the data cards are set to indicate if the data is protected or unprotected as further discussed in Column 9 Lines 39-47. By using an apparatus and corresponding method for copyrighting protected and unprotected data

contents allows for a clear indication of what type of data contents is present on that particular card.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to use the image data processing of the digitally reproducing an optical data image, as disclosed by Yamauchi et al, and incorporate the recording contents to be copyright-protected and/or copyright-unprotected on both first and second memory cards, as disclosed by Watanabe et al, in order to protect the data contents within the memory cards or allow the appropriate data to be recorded onto the memory cards of the system.

[claims 2 & 14]

In regard to Claims 2 and 14, Yamauchi et al, discloses a terminal apparatus wherein the insertion hole has a plurality of slots into which a plurality of memory cards may be inserted concurrently (Figure 62 elements 614 and 615 are slots for memory cards).

[claims 3 & 15]

In regard to Claims 3 and 15, Yamauchi et al, discloses a terminal apparatus wherein the insertion hole has a single slot which accommodates only one memory card and into which said first memory card is inserted to have recorded contents before the first or second memory card is removed from said insertion hole and replaced by the first or second memory card inserted (Figure 60 element 533 shows the single slot as well as the one memory card while Figure 105a shows the contents of the memory cards and the contents to be recorded as well as the designations (memory card one or two).

[claims 4 & 16]

In regard to Claims 4 and 16, Yamauchi et al, discloses an apparatus for recording contents such as music, videos, and games (Figure 74 shows the recording contents can be music, videos, and games through the input of elements 602, 814, 817, and 818 and recording onto the memory card 400 or hard disk 819 or other mediums).

[claims 5, 6,17, & 18]

In regard to Claims 5 and 17, Yamauchi et al discloses an apparatus for recording contents while Watanabe et al discloses an copyright protection contents apparatus and corresponding method; however, fails to disclose that the copyright-unprotected contents are constituted by a copyright free software that is made up of privately produced contents.

The examiner takes official notice that it is well known in the art that to produce copyrighted material a software application would be used and thereby the software can be produced privately and independent from the apparatus. It would have been obvious to one skilled in the art at the time of the invention to disclose that copyright free software is used when producing a copyright protected or unprotected contents.

[claims 7, 11, 19, & 23]

In regard to Claims 7, 11, 19, and 23, Yamauchi et al discloses a terminal apparatus wherein the controlling means transfers the recorded contents from said first or second memory card to first or second memory card inserted in an insertion hole, before erasing the contents from the first or second memory card (Figure 115 shows the varying modes that can occur to the memory cards including copy, exchange, and/or deletion. The process is further described in relation to the memory cards in Column 58 Lines 35+).

[claims 8, 12, 20, & 24]

In regard to Claims 8, 12, 20, and 20, Yamauchi et al discloses a terminal apparatus comprising a comparing:

- means for comparing a recordable capacity of the first or second memory card inserted in the insertion hole with the capacity of the recorded contents of first or second memory (Figure 76 card type connector 504 confirms various pieces of information added to the data obtained from the memory card 400 or card type connector 504 thereby checking the recording capacity of each card);
- controlling means permits the transfer of the recorded contents between the memory cards if said recordable capacity of the first or second memory card is judged to be greater than the capacity of the recorded contents in the first and second memory card upon comparison by comparing the contents (Figure 76 card selection control unit 629a controls and permits the transfer of data from the first and second memory card depending on the remaining capacity of the cards);
- controlling means inhibiting the transfer if the recordable capacity of the second memory card is judged to be less than the capacity of the recorded contents of the first or second memory card (Figure 76 card data input/output control unit 629c controls the transfer of data depending on the recording capacity set by the card type connector 504).

[claims 9 & 21]

In regard to claims 9 and 21, Yamauchi et al discloses a terminal apparatus comprising:

- microphone (Figure 1 camera incorporates a microphone)
- A/D converting (Figure 1 element 608);

- Compression processing means for subjecting to a predetermined compression process and digital audio signal following the conversion by the A/D (Figure 1 element 609);
- Compressed digital and audio signal from the compression processing means is recorded by the first or second memory card (Figure 1 shows the recording onto the data bus for later transfer and recording onto the memory cards).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mizuta (US 5,131,091);
- Ando et al (US 6,731,863); and
- Clark (US 6,343,280).

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

703.872.9306 (for formal communication intended for entry)
703.308.5359 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.

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If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley, can be reached at (703) 305-4856.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jam Vent

Miss Jamie Vent

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TECHNOLOGY CENTER